

REMARKS

The Office Action in the above-identified application has been carefully considered and this amendment has been presented to place this application in condition for allowance.

Accordingly, reexamination and reconsideration of this application are respectfully requested.

Initially, Applicant's attorneys would like to thank the Examiner for conducting a telephonic interview on October 20, 2004. As a result of this interview, it is the Applicant's attorneys understanding that the Examiner has withdrawn the objection to the previously presented amendment to the specification under 35 U.S.C. § 132. As clarified by the interview, support for the newly added language can be found in among other places claim 6 of the parent application, now U.S. Patent No. 6,074,293. Specifically, the Examiner's attention was brought to the claim language stating that the device comprises "a relief surface for guiding said distal end in a non-cutting mode." The Examiner's understanding in this matter and withdrawal of the objection to the newly added matter is greatly appreciated.

Claims 26-28 and 30-41 are in the present application. Claims 26 and 30 have been amended herein and claim 42 has been cancelled.

In the previous office action of 8/19/2003 the Examiner indicated that claims 27 and 28 contain patentable subject matter and would be allowed if re-written in independent form. In response, to the Examiner's statements new claims 30 and 31 were added by the previous amendment to, which incorporate the Examiner's suggestion. As the Examiner noted in this office action, claim 30 was unclear and rejected under 35 U.S.C. § 112, first paragraph. In response, claim 30 has again been amended to clarify the confusing language and fully incorporate the allowable subject matter of claim 27. Accordingly, it is respectfully submitted

that claims 30 and 31 contain subject matter which the Examiner has indicated patentably distinguishes over the cited prior art and are therefore allowable.

The Examiner has rejected claims 26-28 and 31 under 35 U.S.C. § 112, second paragraph. Specifically, the Examiner states that while claim 26 appears to be directed to the embodiment shown in Figs. 11-13, claims 27 and 28 appear to be directed to the embodiments of Figs. 4-9. It is respectfully submitted that the Examiner refer to pages 17-19 of the specification where among other things a groove 54, which is also described as a cutting surface, is interrupted by a relief 82. Thus Fig.11 depicts an active cutting surface 54 adjacent to a relief 82, as recited in claim 27. Further, it is respectfully submitted that Figs. 11-13 depict the cutting surface or groove 54 as having a semi-circular shape. To the best of the applicant's attorneys understanding semi-circular falls within the meaning of "curvilinear-shaped," as recited in claim 28. Accordingly, at least one interpretation claims 27 and 28 are fully supported by Figs. 11-13. By no means, however, do the Applicant's attorneys intend such an interpretation of the claim to be binding upon the Applicant or the interpretation of the claims discussed herein. The foregoing is provided by way of a single example as to how the elements of claims 26-28 are fully supported by Figs. 11-13. Other interpretations and embodiments are considered within the scope of the claims. Therefore, the Examiner is respectfully requested to withdraw the rejection of claims 26-28 under 35 U.S.C. § 112, second paragraph.

In the Office Action claims 26-28, and 30-41 are rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 3,797,334 to Sinclair.

It is respectfully submitted that claim 26 as amended patentably distinguishes over Sinclair, for at least the following reasons. Sinclair defines a "groove" in the specification as an area bounded by a vertically disposed wall 20 and an inclined wall 22, the Examiner has labeled

this area a “cavity.” (Office Action dated, May 28, 2004, para. 9). Bearing the Examiner’s labeling in mind, it is respectfully submitted that as interpreted by the Examiner Sinclair does not teach a “cavity further comprising at least one groove **formed inside said cavity**.” Rather, as clearly shown in Fig. 3, Sinclair teaches a groove 14 formed outside of a elongated bore 15. Even accepting the Examiner’s interpretation of element 14 of Sinclair being a “cavity”, there is then no “groove” formed inside of the cavity as recited by claim 26 as amended.

Further, the Sinclair reference does not teach **a cavity** disposed in the device **comprising a portion of a negative image surface** of a portion of a tool to be finished. As discussed above, the groove of Sinclair is defined in the specification as an area bounded by a vertically disposed wall 20 and an inclined wall 22. As shown in Fig. 3 of Sinclair, the cutting surface is disposed on a file, and not one of the two surfaces that define the groove. Accordingly, even as defined by the Examiner, which is contrary to the definition provided by Sinclair, the cavity does not comprise “a negative image surface,” rather the file does. Further, the groove as defined by Sinclair does not teach a “groove having an active cutting surface” as recited in claim 26 of the present invention, again it is the file and not the groove which has the active cutting surface. Accordingly, it is respectfully submitted that Sinclair does not teach each and every element of the claimed invention. Therefore, claim 26 patentably distinguishes over the cited reference and is allowable. Claims 27-28 which depend from claim 26 are allowable therewith.

As regards claim 32, it is respectfully submitted that Sinclair does not teach “at least one negative image surface...for supporting said portion of said tool.” Accordingly, claim 32 patentably distinguishes over Sinclair and is allowable. Claims 33-35 which depend from an allowable base claim are allowable therewith.

With respect to independent claim 36, it is respectfully submitted that Sinclair does not teach "a relief surface for non-abrasively supporting a portion of said tool." Accordingly, claim 36 patentably distinguishes over Sinclair and is allowable. Claims 37-41 which depend from an allowable base claim are allowable therewith.


Accordingly, it is submitted that claims 26-41 patentably distinguishable over the prior art of record in this matter and are allowable. Accordingly, a Notice of Allowance is earnestly solicited.

The Commissioner is authorized to charge any additional fee that may be required to Deposit Account No. 50-0320.

Respectfully submitted,

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